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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,386	03/09/2001	John Michael Astle	R&G C-319	7391

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EXAMINER

CHEVALIER, ROBERT

ART UNIT PAPER NUMBER

2616

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/803,386

Applicant(s)

ASTLE ET AL.

Examiner

Bob Chevalier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/27/01; 7/17/02
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2, 4, 6-10, 12-24, 26, 29, and 31, are rejected under 35 U.S.C. 102(b) as being anticipated by the submitted prior art of Kong (WO 96/13932).

The submitted prior art of Kong discloses a video recording apparatus that shows all the limitations recited in claims 1, 19-22, 24, and 31, including the feature of at a broadcaster location receiving information identifying a recorder at a recorder location and a program or program type to be recorded by the recorder (See Kong's page 7, lines 20-24), the feature of generating an output signal containing information identifying the recorder and the program or program type to be recorded by the recorder and multiplexing the output signal with a broadcast signal and transmitting the multiplexed signal (See Kong's page 7, lines 28-30), the feature of at a recorder location receiving the transmitted multiplexed signal and separating the transmitted multiplexed signal into a broadcast signal and a data signal containing information identifying a recorder and the program or program type to be recorded by the recorder (See Kong's page 19, lines 30-34), the feature of detecting when the information identifying a recorder in the data signal identifies that particular recorder at the recorder location and the program store for storing the program or program type identifying information (See Kong's page 19, lines 34-36), the feature of determining whenever a program or program type identified

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by the stored information is being transmitted and in response thereto to activate the broadcast signal recording device (See Kong's page 19, line 37, to page 20, line 2), and the feature of the user at a remote location transmitting to the broadcaster location information identifying a recorder at a recorder location and a program or program type to be recorded by the recorder as specified in the present claims 1, 19-22, 24, and 31. (See Kong's page 20, lines 20-24, and page 19, line 20).

With regard to claim 2, the feature of the broadcast television signal as specified thereof is present in the submitted prior art of Kong. (See Kong's Figure 1, components 63-64).

With regard to claims 4, 6, and 26, the feature of the telephone specified thereof is present in Kong's page 19, line 20.

With regard to claims 7, 23, and 29, the feature of the signal being a digital signal as specified thereof is present in Kong. (See Kong's Figure 1, component 80).

With regard to claims 8-9, the feature of repeating the individual output as specified thereof is present in Kong. (See Kong's page 7, line 38, to page 8, line 3).

With regard to claim 10, the feature of the VTR specified thereof is present in Kong. (See Kong's Figure 1, component 40).

With regard to claim 12, the feature of comparing the timing information stored in the program data store with the current time information as specified thereof is present in Kong. (See Kong's page 19, line 37, to page 20, line 2).

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With regard to claim 13, the feature of comparing received codes with the stored codes as specified thereof is present in Kong. (See Kong's Figure 1, component 33b and 90).

With regard to claim 14, the feature of receiving user identification from the user as specified thereof is present in Kong. (See Kong's page 19, line 20).

With regard to claim 15, the feature of issuing a unique user identification as specified thereof is present Kong. (See Kong's page 8, lines 26-36).

With regard to claim 16, the feature of the conditional access-enabling device at the recorder location as specified thereof is present in Kong. (See Kong's page 19, lines 35-36).

With regard to claim 17, the feature of tuning to the reception channel when a program is to be recorded as specified thereof is present in Kong. (See Kong's page 20, lines 1-2).

With regard to claim 18, the feature of the broadcast signal including schedule information as specified thereof is present in Kong. (See Kong's Figure 7).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 3, 5, 25, and 27-28, are rejected under 35 U.S.C. 103(a) as being unpatentable over the submitted prior art of Kong (WO 96/13932) in view of the submitted prior art of Kazuhiro (EP 0805594).

Kong discloses a video recording apparatus that shows substantially the same limitations recited in claims 3, 5, 25, and 27-28, including the feature of having a user communicating recorder information to a broadcaster as specified in the present claims 3, 5, 25, and 27-28. (See Kong's page 19, line 20).

Kong fails to specifically disclose the feature of communicating to the broadcaster by means of a computer, the Internet as specified in the present claims 3, 5, 25, and 27-28.

Kazuhiro discloses a video recorder which includes the capability of communicating to a broadcaster by means of a computer, the Internet, as specified in the present claims 3, 5, 25, and 27-28. (See Kazuhiro's Figure 1).

It would have been obvious to one skilled in the art to modify the Kong's recording apparatus wherein the communication means provided thereof would incorporate the capability of communicating to the broadcaster via a computer, the

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internet in the same conventional manner as is shown by Kazuhiro. The motivation is to make the system more reliable by making the communication means more efficient as suggested by Kazuhiro. Kazuhiro makes it well known and desirable to communicate to a broadcaster by the Internet.

6. Claims 11, and 30, are rejected under 35 U.S.C. 103(a) as being unpatentable over the submitted prior art of Kong (WO 96/13932) in view of Official Notice.

Kong discloses a video recorder that shows substantially the same limitations recited in claims 11, and 30, including the feature of recording video signal on a recording medium. (See Kong's Figure 1, component 40).

Kong fails to specifically disclose the feature of the recording device being a hard disk recorder as specified in the present claims 11, and 30.

Examiner takes Official Notice in that it is notoriously well known in the video recording art to have a hard disk recorder for the purpose of recording video data thereon as specified in the present claims 11, and 30.

It would have been obvious to one skilled in the art to modify the Kong's recording's apparatus wherein the recording means provided thereof would incorporate the capability of a hard disk recorder for the purpose of recording the video data in the same conventional manner as is well known in the prior art. Examiner has taken Official Notice. The motivation is increase the recording density of the recording means as suggested in the prior art.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Mizutani discloses a remote accessible programming.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bob Chevalier whose telephone number is 571-272-7374. The examiner can normally be reached on MM-F (9:00-6:30), second Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on 571-272-7950. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

B. Chevalier
June 27, 2005.


ROBERT CHEVALIER
PRIMARY EXAMINER